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PATENT TRADEMARK OFFICE

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Attorney Docket No. 05725.0777-00

Application No.: 09/821,480

Customer No.: 22,852

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

David W. CANNELL et al.

Application No.: 09/821,480

Filed: March 30, 2001

For: HEAT ACTIVATED DURABLE
STYLING COMPOSITIONS
COMPRISING C₃-C₅
MONOSACCHARIDES AND
METHODS FOR SAME

Group Art Unit: 1615

Examiner: L. Channavajjala

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In the Office Action mailed April 24, 2002, the Examiner has required restriction between the following groups of claims:

- Group I** Claims 1-40, drawn to a composition, classified in class 424, subclass 70.2;
- Group II** Claims 41-85, 152 and 153 drawn to a method for non-permanent shaping and shape retention, classified in class 424, subclass 70.1;
- Group III** Claims 86-119, 154 and 155, drawn to a method for non-permanent shaping of hair, classified in class 424, subclass 70.1; and
- Group IV** Claims 120-151, drawn to a composition, classified in class 424, subclass 70.1.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

The restriction requirement, as set forth above and on pages 2-3 of the Office Action, is respectfully traversed. However, to be fully responsive to the restriction requirement, Applicants elect, with traverse, the subject matter of Group IV, Claims 120-151.

Applicants refer the Examiner to M.P.E.P. § 803, which sets forth the criteria and guidelines for Examiners to follow in making proper requirements for restriction. The M.P.E.P. instructs Examiners as follows:

If the search and examination of an entire application can be made without serious burden, the Office must examine it on the merits, even though it includes claims to distinct or independent inventions.

M.P.E.P. § 803 (emphasis added).

Here, the Examiner has not shown that examining the above groups together would constitute a serious burden. In fact, according to the present Office Action, Groups I, II, III, and IV are all classified in the identical class (class 424), Groups II, III, and IV are all classified in the identical subclass (subclass 70.1), and Group II is classified in subclass 70.2 which is indented under subclass 70.2 (see U.S.P.T.O. Manual of Classification). Accordingly, a search for these groups of claims will substantially, if not completely, overlap. Thus, for at least this reason, Applicants respectfully submit that the restriction requirement is in error and request that the requirement be withdrawn.

Applicants acknowledge the Examiner's election of species requirement at paragraph 10, page 4 of the present Office Action which refers solely to Groups I and II. As Applicants have elected, with traverse, Group IV, this Response is fully responsive to the present Office Action.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

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Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, she is invited to call the undersigned at (202) 408-4173.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Chalicia V. Warrington, Reg No. 39,064
By: *for Anthony C. Tridico*
Anthony C. Tridico
Reg. No. 45,958

Dated: May 24, 2002

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FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com